

Appl. No. 10/085,396  
Docket No.: D4865-00004  
RCE Preliminary Amendment  
in response to Final Office Action dated 11/03/2005

### **REMARKS/ARGUMENTS**

As a result of this Preliminary Amendment, claims 17-20 are under active consideration in the subject patent application. A Request for Continuing Examination (RCE) application has been filed in conjunction with this response to the Final Official Action mailed on November 3, 2005. **The Director is hereby authorized to charge the RCE fee required under 37 CFR 1.17(e), namely \$395. 00, and any additional fees required to Deposit Account No. 04-1679.**

In the Final Action, the Examiner has:

- 1) removed the previous rejections under 35 U.S.C. §101;
- 2) considered the Affidavit under 37 CFR §1.131, filed on August 18, 2005, but found it allegedly ineffective to overcome the rejection of the proposed combination of U.S. Patent No. 5,983,198, issued to Mowery et al., and U.S. Patent No. 4,615,351, issued to Schliefer et al.;
- 3) rejected claims 17 and 20 under 35 U.S.C. §103(a) in view of the proposed combination of U.S. Patent No. 5,983,198, issued to Mowery et al., and U.S. Patent No. 4,615,351, issued to Schliefer et al.;
- 4) rejected claim 18 under 35 U.S.C. §103(a) in view of the proposed combination of U.S. Patent No. 5,983,198, issued to Mowery et al., U.S. Patent No. 4,615,351, issued to Schliefer et al., and U.S. Statutory Invention Registration No. H1743, issued to Graves et al.; and

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5) rejected claim 19 under 35 U.S.C. §103(a) in view of the proposed combination of U.S. Patent No. 5,983,198, issued to Mowery et al., U.S. Patent No. 4,615,351, issued to Schliefer et al., and U.S. Statutory Invention Registration No. H1743, issued to Graves et al.

With regard to Items 1 and 2, Applicant acknowledges with appreciation the Examiner's removal of the rejection under 35 U.S.C. §101.

The Examiner is incorrect, however, with regard to his allegation that the Affidavit under 37 CFR §1.131, filed on August 18, 2005 is ineffective to overcome the rejection based upon a proposed combination of U.S. Patent No. 5,983,198, issued to Mowery et al., and U.S. Patent No. 4,615,351, issued to Schliefer et al. In particular, the Examiner states "*... the applicant's first and only mention of automatically ordering materials and automatically directing a transport vehicle to deliver the materials is found in an Engineering Report dated April 13, 1998. . .*" This statement is simply not true.

Contrary to the Examiner's stated position, evidence is provided, at least at Exhibits A-E of Applicant's Affidavit under 37 CFR §1.131, that categorically demonstrates that Applicant was in full possession of all aspects of his invention well before the effective date of the Mowery reference, i.e., prior to April 23, 1996, including automatically ordering materials and automatically directing a

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transport vehicle to deliver the materials.<sup>1</sup> Reconsideration of the Examiner's position with regard to the effectiveness of the August 18, 2005 Affidavit under 37 CFR §1.131, to overcome the Mowery et al., reference is respectfully requested for the following reasons.

More particularly, the April 13, 1998 engineering report, referred to by the Examiner, is identified in the August 18th Affidavit as Exhibit L. It is a report from Steven G. Lowry & Associates, Inc., of Mechanicsburg, Pennsylvania. As the Examiner admits, Mr. Lowry does discuss ". . .automatically ordering materials and automatically directing a transport vehicle to deliver the materials. . ." at page 1 under the heading **EXISTING SYSTEM**. Thus, Mr. Lowry is clearly describing a system as he found it, and as it had been previously implemented prior to April 13, 1998. In the first full paragraph of that report, second line, Mr. Lowry in fact states:

". . . this equipment was supplied by Magyar & Associates, and installed by TriStar, Inc. . . ."

As outlined in Applicant's Affidavit, Applicant is not trained as an engineer, nor does he possess any special education or background in any of the engineering or scientific arts. As a consequence of his lack of the engineering skill necessary to pursue his invention, he had to seek-out the advice and assistance of companies and individuals that specialize in the design and manufacture of inventory level systems in order to both memorialize his conception of the invention

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<sup>1</sup> An additional copy of Applicant's August 18, 2005 Affidavit under 37 CFR §1.131, is enclosed for the convenience of the Examiner.

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and to reduce it to practice. Companies that he contacted included Magyar Associates and Apptech Engineered Systems of Plumsteadville, PA. Personnel from each of the foregoing companies were provided with a verbal disclosure of a variety of embodiments of his invention prior to April 23, 1996.

Referring to Exhibit F of the Affidavit under 37 CFR §1.131, i.e., Michael Karpa's sworn statement, Mr. Karpa swears to having been approached by Dave Wallace on May 30, 1996, to discuss implementation of Dave Wallace's invention. Mr. Karpa states that on the week of June 3, 1996, he made a sales call at Applicant's place of business (J.P. Donmeyer) in Ono, Pennsylvania, and stated that he was a representative of Kistler Morse, and an employee of Magyar Associates. These are the very same Magyar Associates referred to by Mr. Lowry as having installed the first system based on the conceptions of Applicant's invention related to them during this June 3, 1996 meeting. Thus, Applicant had been in full possession of a conception of his invention as of June 3, 1996. It should be noted by the Examiner that in his Affidavit, Applicant discusses the unsuitability of the Magyar installation, and Applicant's subsequent hiring of Mr. Lowry to complete the task.

More importantly, Mr. Karpa and Magyar Associates were not the first or only engineering firm to have been contacted by Applicant for implementation of the invention he had fully conceived. For example, on or about February 12, 1996, Mr. Fred Coffey discussed options for using Apptech Engineered Systems' plumb bob system in such a manner to provide the ability to receive updates from

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multiple silo-based units back to a central computer. Mr. Coffey thought that Apptech Engineered Systems could design a "black box" for each site which could work on a modem line.<sup>2</sup>

On or about March 28, 1996, Peter R. Wells of Apptech Engineered Systems, conducted a sales presentation at J.P. Donmoyer. Mr. Wells was the technical representative working at the direction of Mr. Coffey. Mr. Wells presented a potential embodiment of Applicant's invention incorporating a "black box" to operate as a remote telemetry unit. This devise would transmit data, via modem, to any source by a phone line. At that March 28, 1996 meeting Applicant specifically asked Mr. Wells whether this so-called "black box" could call Applicant's PC automatically. It is axiomatic that one must fully conceive of the subject matter of a question prior to asking that question. Mr. Wells' April 8, 1996 letter responds to Applicant's question, in part, as follows:

"... As a result of our meeting on March 28, I have done some additional investigation into the silo communications system we discussed and have the following answers to your questions:

1. It is possible to have the "black boxes" call your PC automatically..."

The Wells letter is captioned, in the upper right-hand corner, "System and Components for Handling Bulk Solids." A copy of Mr. Wells' April 8, 1996 letter

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<sup>2</sup> See Applicant's Affidavit under 37 CFR §1.131, paragraphs 10-20.

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(Affidavit's Exhibit E) is attached to this Preliminary Amendment separately for ready reference by the Examiner.

Thus, at least as early as March 28, 1996, Apptech Engineered Systems, Inc., was approached by Dave Wallace, made aware of his invention, and were left with several questions to answer, including whether Apptech could implement automatic calling of a central computer used in a method for a transportation carrier to maintain sufficient quantities of dry bulk materials at a remote manufacturing site comprising, among other steps, automatically ordering additional dry bulk materials from central computer and automatically directing a transport vehicle to deliver those materials. That Mr. Wallace and his company eventually elected to work with Mike Karpa and Magyar only further supports the fact that Mr. Wallace was fully in possession of his invention prior to April 23, 1996. He had been interviewing several possible vendors as to their respective capabilities to reduce his invention to practice since at least as early as February of 1996 (See, e.g., Exhibits A-E of Applicant's August 18<sup>th</sup> Affidavit).

Accordingly, the Examiner's position that Applicant's actual earliest conception of the invention related automatically ordering materials and automatically directing a transport vehicle to deliver the materials did not occur until April 13, 1998, flies in the face of at least the letter of Mr. Peter R. Wells, dated April 8, 1996, and therefore does not stand up to the facts presented in Applicant's August 18, 2005 Affidavit under 37 CFR §1.131.

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Therefore, Applicant requests reconsideration and entry of the Affidavit under 37 CFR §1.131 submitted August 18, 2005, and the removal of the Mowery reference from consideration in the present application.

With regard to Items 3-5, the Examiner has improperly relied upon U.S. Patent No. 5,983,198, issued to Mowery et al., as the underlying basis for all of the substantive rejections presented in the Official Action mailed on November 3, 2005. The Mowery patent issued on November 9, 1999, from Application Serial No. 08/636,289, filed April 23, 1996. Thus the Mowery reference issued less than one year from the earliest filing date claimed by the instant application. The claims of the Mowery reference are directed to a wholly distinct and separate invention when compared to Applicant's claimed invention. Applicant respectfully submits that the Mowery reference is not valid prior art with respect to the instant Application, since the present invention was conceived prior to April 23, 1996, as evidenced by at least the April 8, 1996 letter of Mr. Peter R. Wells, and Applicant worked diligently to an actual reduction to practice of his invention in September of 1998, when a working embodiment that was suitable for its intended purpose was completed at the Nucor facility in Darlington, South Carolina.

In support of Applicant's position that the Mowery reference is not valid prior art, an Affidavit under 37 C.F.R. §1.131, including exhibits A-L, executed by the inventor David B. Wallace, had been submitted to the Examiner on August 18, 2005, and a copy of that Affidavit is attached to this Preliminary Amendment. This Rule 1.131 Affidavit of David B. Wallace and its supporting Exhibits and

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Affidavits provide ample factual documentary evidence of Applicant's conception of his invention prior to April 23, 1996, and of his diligence in moving from conception to a reduction to practice. Accordingly, the Mowery reference is not valid prior art with respect to Applicant's invention.

Since the Mowery reference cannot be said to be valid prior art, any combination of the Mowery reference with the disclosure in U.S. Patent No. 4,615,351, issued to Schliefer et al., or U.S. Statutory Invention Registration No. H1743, issued to Graves et al., is invalid, and must be withdrawn by the Examiner. Reconsideration and withdrawal of the rejection of claims 17-20 under 35 U.S.C. §103, are respectfully requested.

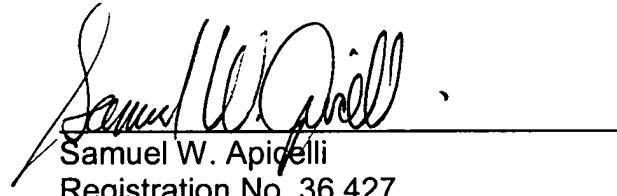
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Applicant respectfully requests that a timely Notice of Allowance be issued  
in this case.

If a telephone conference would be of assistance in advancing  
prosecution of the above-identified application, Applicants' undersigned Attorney  
invites the Examiner to telephone him at 215-979-1255.

Dated: 11/24/06

Respectfully submitted,



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